

Please amend the application as follows:

**In the Claims:**

Please cancel claims 6 and 18.

**REMARKS**

In the Office Action mailed July 22, 2002, the Examiner rejected claims 1-23. The Examiner objected to claim 18 for failing to further limit the subject matter of the claim from which it depends. The Examiner also rejected claims 1, 3, 4, and 6-10 under 35 U.S.C. §1-3(a) as being unpatentable over U.S. Patent No. 6,024,471 to McDermott in view of U.S. Patent No. 3,160,722 to Sellers. Also, the Examiner rejected claims 2, and 11 under 35 U.S.C. §103(a) as being unpatentable over McDermott in view of Sellers and further in view of U.S. Patent No. 6,095,661 to Lebens et al. ("Lebens"). The Examiner also rejected claim 5 under 35 U.S.C. §103(a) as being unpatentable over McDermott in view of Sellers and further in view of U.S. Patent No. 6,193,388 to Halasz. Finally, the Examiner rejected claims 12-15, 17, and 18-21 under 35 U.S.C. §103(a) as being unpatentable over Halasz in view of McDermott.

In view of the remarks set forth herein, Applicants respectfully submit that all pending claims, claims 1-5, 7-17, and 19-23 are in condition for allowance.

**I. Objection Under 37 C.F.R. 1.75(c)**

The Examiner objected to claim 18 under 37 C.F.R. §1.75(c) for failing to further limit the subject matter of the claim from which it depends. The Applicants are somewhat puzzled by this rejection. Applicants would like to point out that claims 6 and 18 were canceled from the application in the last Amendment mailed on March 21, 2002. Applicants assume the Examiner simply failed to notice this and these claims are therefore again canceled from the application in this Amendment. Applicants therefore respectfully request withdrawal of this objection.

**II. Rejection Under §103(a)**

**A. Claims 1, 3, 4, and 6-10 are Patentable over McDermott in View of Sellers**

The Examiner rejected claims 1, 3, 4 and 6-10 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,024,471 to McDermott in view of U.S. Patent No. 3,160,722 to Sellers. The Examiner argued that McDermott discloses a housing, at least one light emitting diode (LED) mounted within the housing generating an LED beam and serving as a light source for the flashlight, and an adjustable switch coupled to a variable resistor for controlling the level of optical output. The Examiner also argued that Sellers discloses a flashlight with a reflector extending from an end of the housing for focusing and dispersing the LED beam to a desired light contour and that it would have been obvious to combine the two references since reflectors are known in the art. With respect to a reflector that is selectively adjustable for focusing and dispersing the LED beam as desired, the Examiner argued that it would have been obvious to have made an adjustable reflector in a flashlight. In addition, the Examiner argued that McDermott discloses a switch to selectively turn on and off any select number of the at least one LEDs to allow a user to choose different illumination levels.

Applicants submit that the subject matter embodied in claims 1, 3, 4 and 6-10 is patentable over McDermott in view of Sellers. First, there is no motivation to combine the two references. To properly reject a claim under §103, there must be some suggestion or motivation to combine the two references. Absent such a suggestion, there would be no reason why one skilled in the art would consult the particular combination of references cited by the Examiner.

To maintain an obviousness rejection based on a combination of references, the Examiner must present facts and reasons supporting his conclusion that it would be obvious to combine those references. *In re Lee*, 61 USPQ2d 1430 (Fed. Cir. 2002). By failing to provide a full and reasoned explanation for his obvious to combine conclusion, the Examiner has failed to meet his burden under §103.

Here, Sellers is directed toward a convenient and efficient switch mechanism comprising liquid metal housed within a flexible container and adapted for spreading into circuit making contact. McDermott, on the other hand, is concerned with a switch for a flashlight capable of providing a variety of output light modes by varying the intensity of the emitted light by varying the voltage supplied to

the light. The invention of Sellers, unlike McDermott is only capable of providing two states, "ON" and "OFF". Thus, the two references are concerned with completely different objects and provide no incentive for one skilled in the art to combine their teachings.

Second, even if the two references could somehow be combined, such a combination would still not meet all the limitations of the present claims. As clearly seen in Fig. 1 and recited in claim 1 of the present application, from which the remainder of the rejected claims depend, the present invention includes "a reflector [50] extending from an end of the housing". Neither Sellers nor McDermott disclose such a reflector. As seen in Fig. 1 of Sellers, the "electrically conductive reflector" 16 is clearly within the casing 13 and does not, therefore, "extend from an end" of it. Likewise, McDermott fails to disclose any reflector. Since neither reference alone discloses nor suggests this feature, any combination of the two references would lack such a reflector element as well.

Further, and with respect to claim 4, which depends from claim 1 and further recites that the "reflector is selectively adjustable for focusing and dispersing the LED beam as desired", any combination of Sellers and McDermott also fails to disclose or suggest this feature. The Examiner cites *In re Stevens*, 101 USPQ 284 (CCPA 1954) for the proposition that adjustability involves only routine skill in the art. The Examiner misconstrues the holding of that case. In *Stevens*, the Court held that because there was an art recognized need for adjustment in a fishing rod, claims directed to a handle having an adjustable finger hook were not patentable over known handles without such an adjustable hook. The specific holding in *Stevens* is of course, only applicable to that case and is irrelevant here. The more general holding is also inapplicable because the basis for that holding, i.e. a recognizable need for an adjustable element, is not present in this case. That is, the Examiner has failed to identify any reference indicating that such a recognizable need exists.

The Examiner goes on to state that such a feature is known in the art and cites U.S. Patent No. 6,004,008 to Lai and 6,193,388 to Halasz et al. as both "clearly teach[ing] such an embodiment". Even assuming the truth of this statement, it is not dispositive of the issue. The fact that all the elements of a claim exist in the prior art is not enough, there must also be some motivation or suggestion to combine the elements to make the claimed invention. See MPEP, §2143.0. The Examiner

has failed to show such a suggestion. For at least these reasons, it is requested that the Examiner withdraw this rejection.

**B. Claims 2 and 11 are Patentable over McDermott in View of Sellers and Further in View of Lebens**

The Examiner also rejected claims 2 and 11 under 35 U.S.C. §103(a) as unpatentable over McDermott in View of Sellers and further in view of U.S. Patent No. 6,095,661 to Lebens.

The Examiner cites Lebens as disclosing the feature of a flashlight comprising a plurality of LEDs arranged concentrically around a single LED and as containing a pulse control system. Even assuming the truth of this statement and the appropriateness of combining McDermott, Sellers, and Lebens, such a combination would still not disclose or suggest all of the elements and recitations of claims 2 and 11.

Claims 2 and 11 depend from claim 1, and therefore contain all of the elements thereof. Thus, even assuming that Lebens discloses the specific features recited in claims 2 and 11, the stated combination of McDermott, Sellers and Lebens fails to disclose or suggest all of the elements found in claim 1 (and implicitly claims 2 and 11) for the reasons stated above.

The applicants therefore request that the Examiner withdraw this rejection.

**C. Claim 5 is Patentable over McDermott in View of Sellers and Further in View of Halasz**

The Examiner also rejected claim 5 under 35 U.S.C. §103(a) as being unpatentable over McDermott in view of Sellers and further in view of U.S. Patent No. 6,193,388 to Halasz et al. It is the Examiner's position that Halasz discloses a flashlight having a fixed reflector and a selectively moveable LED light source.

Despite the Examiner's argument, Halasz clearly does not teach a flashlight having a fixed reflector and a selectively moveable LED light source. Claim 6, which the Examiner cites for his argument, recites a flashlight having a "head assembly means for positioning said lens and said reflector relative to [a] light bulb". The head assembly further includes a bezel which is rotatable to "cause said reflector to axially move relative to said light bulb." Thus, Halasz discloses at most a

flashlight having a fixed light source and a moveable reflector, not the other way around. Thus, the combination of McDermott, Sellers and Halasz fails to disclose or suggest all of the features of claim 5.

Furthermore, claim 5 depends from claim 1, and therefore contains all of the elements thereof. Thus, even assuming that Halasz discloses the specific features recited in claim 5, the stated combination of McDermott, Sellers and Halasz fails to disclose or suggest all of the elements found in claim 1 (and thus claim 5) for the reasons stated above.

**D. Claims 12-15, 17, and 18-21 are Patentable over Halasz in View of McDermott**

The Examiner rejected claims 12-15, 17 and 18-21 under 35 U.S.C. §103(a) as being unpatentable over Halasz in view of McDermott. It is the Examiner's position that Halasz discloses a housing having at least one LED mounted within the housing generating a mechanically adjustable LED beam and serving as a light source, a reflector extending from an end of the housing for focusing and dispersing the at least one LED to a desired light contour being selectively adjustable [sic], the LED is selectively moveable and the reflector is fixed.

First, despite the Examiner's arguments, Halasz does not disclose a mechanically adjustable LED beam as that phrase is used in the present claims. Halasz does disclose a rotatable head assembly, but such rotation of the head assembly only serves to turn the flashlight ON and OFF by selectively coupling the light bulb with the batteries. (See, e.g. col. 12, ln 15-33). Thus, this feature does not adjust the LED beam by controlling the focus and dispersion of the light as disclosed in the present invention. (See page 5, ln 25-30). Because the noted combination of Halasz and McDermott fails to disclose or suggest this feature, it fails to render claim 12 unpatentable under §103. Because claims 13-15, 17 and 18-21 all depend from claim 12 and contain all the features and recitations therein, the combination fails to render these claims unpatentable as well for the same reason.

Second, and with respect to claims 14 and 15, the noted combination of Halasz and McDermott fails to disclose or suggest a flashlight having a fixed LED and a moveable reflector for focusing and dispersing the LED beam or a fixed reflector and a moveable LED. As discussed above, the movement of the head assembly in Halasz only serves to turn the flashlight ON and OFF. It does not serve

to adjust the LED beam focus or dispersion. Thus, the noted combination fails to render claims 14 and 15 unpatentable for this additional reason.

Third, and with respect to claim 19, the noted combination of Halasz and McDermott fails to disclose or suggest a flashlight having a switch for selectively turning ON or OFF a select number of LEDs. Both Halasz and McDermott only disclose flashlights having a single light bulb. Thus, they could not possibly teach or suggest switch for turning ON or OFF a number of light bulbs. Thus, the noted combination fails to render claim 19 unpatentable for this additional reason.

**D. Claim 16 is Patentable over Halasz in View of McDermott and Further in View of Lebens**

The Examiner rejected claim 16 under 35 U.S.C. §103(a) as being unpatentable over Halasz in view of McDermott and further in view of Lebens. It is the Examiner's position that a concentric arrangement of LEDs around a single LED is well-known as taught by Lebens.

Even assuming this statement to be true, claim 16 depends from claim 12 and includes all of the features and recitations thereof. Thus, even assuming that Lebens discloses such an arrangement, the stated combination of Halasz, McDermott and Lebens fails to disclose or suggest all of the elements found in claim 12 (and thus claim 16) for the reasons stated above.

**CONCLUSION**

In view of the above remarks, Applicants respectfully submit that the rejections set forth in the Office Action of July 22, 2002 have been overcome. Accordingly, Applicants respectfully submit that all pending claims, claims 1-5, 7-17, and 19-23 are in condition for allowance. Withdrawal of the rejections and early notification of allowability are earnestly solicited. Should any issues remain, the Examiner is encouraged to contact the undersigned to resolve any such issues.

Respectfully submitted,

FAY, SHARPE, FAGAN,  
MINNICH & MCKEE, LLP

Date: \_\_\_\_\_

*Oct 22 2002*

*Joseph E. Waters*

\_\_\_\_\_  
Scott A. McCollister

Reg. No. 33,961

Joseph E. Waters

Reg. No. 50,427

1100 Superior Avenue, Seventh Floor

Cleveland, Ohio 44114-2518

(216) 861.5582